

## **REMARKS**

Claims 1 through 20 are pending in the present application. Claims 9-20 were added. Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 102, Anticipation**

The examiner has rejected claims 1 through 3 and 5 through 8 under 35 U.S.C. § 102(e) as being anticipated by Canaday, et al., Redundant Power Supply System and Method for an Automated Robotic Device in a Data Storage System, U.S. Patent 6,668,991 (Dec. 30, 2003) under the assertion that Canaday shows the claimed inventions. This rejection is respectfully traversed.

Applicants have provided a declaration under 37 C.F.R. § 1.131 with this response. The declaration and attached Exhibit A establish that the claimed inventions were actually reduced to practice before the earliest priority date (June 29, 2001) of Canaday. In addition, the declaration establishes that an inventor of this application, Timothy Ostwald (A.K.A. Ty Ostwald), was an inventor of the subject matter referred to by the Examiner in the previous office action. This fact establishes that Mr. Ostwald had to have been working on the claimed subject matter before June 29, 2001. In turn, this conclusion supports the facts asserted in the declaration and in Exhibit A.

Applicants have established that Applicants actually reduced the devices as claimed before June 29, 2001. Therefore, under 37 C.F.R. § 1.131, Canaday is disqualified as a reference with respect to this application. Accordingly, the anticipation rejections in view of Canaday are moot.

### **II. 35 U.S.C. § 103, Obviousness**

#### **II.A. Basis of Rejections**

The examiner has rejected claims 1-8 under 35 U.S.C. § 103 as being unpatentable over Luffel, et al., Modular Data Storage System Utilizing a Wireless Cartridge Access Device, U.S. Patent 6,222,699 (Apr. 24, 2001) in view of Benson, et al.,

Track Mounted Surveillance System Having Multiple Use Conductors, U.S. Patent 5,241,380 (Aug. 31, 1993) under the assertion that Luffel shows a modular storage library essentially as claimed, except that control of the robots is handled by a wireless control module rather than through rails, that Benson teaches sending power and control signals through the rails is advantageous over wireless communication systems, and that it would have been obvious to modify Luffel by utilizing the rails to send control signals to the robots “as this would be simpler, cheaper, and more reliable than a wireless system.” This rejection is respectfully traversed.

## **II.B. Legal Standards**

A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). The inquiry is not whether each claimed element existed in the prior art, but whether the invention as a whole is obvious in light of the prior art.

## **II.C. The Office Action Has Failed to State Prima Facie Obviousness Rejections of Claims 1-8**

The proposed combination ignores limitations of the claims and therefore the Office Action has failed to state prima facie obviousness rejections of claims 1-8. Independent claims 1 and 8 require that the guide rail form a path that takes the robot out of the line of sight of the controller, while maintaining uninterrupted power and control signals to the robot. The Office Action fails to point out how the proposed combination can meet the claimed limitation. Thus, the Office Action has failed to state prima facie obviousness rejections of claims 1-8. In light of the fact that neither Luffel nor Benson show or suggest the claimed feature, it is clear that the claims are also non-obvious in view of Luffel and Benson. Accordingly, Applicants request that the rejections be withdrawn.

#### **II.D. The Proposed Combination Does Not Result in the Inventions of Claims 1-8**

Claims 1-8 require that the guide rail form a path that takes the robot out of the line of sight of the controller, while maintaining uninterrupted power and control signals to the robot. Luffel shows rectangular room with wall-to-wall storage libraries and a plurality of rails upon which robots move. However, Luffel does not show the claimed limitation regarding the path of the guide rail. Benson shows only a straight rail for video cameras and never discusses the claimed limitation regarding the guide rail. Thus, the proposed combination cannot result in the inventions of claims 1-8. Accordingly, Applicants request that the rejections be withdrawn.

#### **II.E. New Claims 9-20 in Relation to the Proposed Combination**

Regarding claims 9-14, the proposed combination does not result in the claimed inventions. Claims 9-14 require that the guide rail comprise a single track and that the robot receive power from the power source and receive control signals from the controller through the track, exclusive of other components in the library. As discussed in the previous response to office action, Benson shows video cameras mounted on a carriage. The carriage is supported by the track system on which it traverses. Power and control signals are modulated onto a *pair* of conductors mounted adjacent and parallel to the tracks. In addition, Figure 5, as well as the corresponding text beginning at column 4 line 47, clearly shows that the pair of conductors and the track are two separate and distinct entities. Specifically, Figure 5 depicts a track **90** with a pair of conductors **92** mounted adjacent and parallel to the track. The carriage makes contact with this pair of conductors to receive power and control signals. Thus, Benson does not teach or suggest providing power and control signals from a controller directly through a single track on a guide rail. Luffel is silent with regard to the claimed feature. Furthermore, neither reference shows or suggests the claimed feature. Accordingly, the proposed combination cannot result in the inventions of claims 9-14 and, furthermore, claims 9-14 are non-obvious in view of the proposed combination.

Regarding claims 15-20, the proposed combination does not result in the claimed inventions. Claims 15-20 require that the guide rail consist of a single track and that the robot receive power from the power source and receive control signals from the controller through the track, exclusive of other components in the library. Neither Benson nor Luffel show or suggest sending control signals along a guide rail consisting of a single track. Accordingly, the proposed combination cannot result in the inventions of claims 15-20 and, furthermore, claims 15-20 are non-obvious in view of the proposed combination.

#### **II.F. No Motivation to Combine the References**

Applicants respectfully maintain that there is no motivation to combine the references and, regarding claims 1-8, that the Examiner has offered no valid motivation to combine the references. Regarding claims 1-8, neither reference shows or suggests creating a path that takes a robot out of sight of the controller. Regarding claims 9-14, Benson does not teach or suggest providing power and control signals from a controller directly through a single track on a guide rail. Luffel is silent with regard to the claimed feature. Regarding claims 15-20, neither Benson nor Luffel show or suggest sending control signals along a guide rail consisting of a single track. Because neither reference shows or suggests all of the limitations of claims 1-20, and because no other pre-existing motivation to modify the proposed combination exists in the art, there is no motivation to combine the references. Certainly, the Examiner has offered no motivation to meet the limitation in claims 1-8 that the path take the robot out of sight of the controller. Thus, the Office Action has also failed to state prima facie obviousness rejections.

#### **II.G Benson is Non-Analogous Art**

Applicants respectfully maintain that Benson is non-analogous art. In order to rely on a reference as a basis for rejection, the reference must be either in the applicant's field of endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1445 (Fed.

Cir. 1992); *In re Deminski*, 796 F.2d 436, 442, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986). It is necessary to consider the reality of the circumstances--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979).

Benson is concerned with controlling the movement of video cameras and not the control of robots in a data storage environment. Thus, Benson is not in the same field of endeavor as Applicants claims. Likewise, Benson is not reasonably pertinent to the particular problem with which the inventor was concerned. Although Benson does discuss controlling video cameras via paired conductors, the differences between controlling video cameras and controlling robots in a data storage environment would lead one of ordinary skill to avoid Benson as relevant art. Controlling a video camera only requires translating the camera along the rail and rotating or angling the camera to obtain a desired shot. Controlling robots in a data storage environment requires not only translation of the robot and rotating or angling the robot to receive storage devices, but also manipulation of the storage devices. This requires additional control signals which substantially increase the difficulty of enabling the claimed invention. The proposed combination does not show or suggest that this is possible. One of ordinary skill would therefore overlook Benson as relevant a solution to the problem. Thus, one of ordinary skill would overlook Benson as irrelevant to the claimed inventions. Accordingly, Benson is not reasonably related to the problem to be solved and is non-analogous art.

The Office Action states that Benson shows that the carriage could mount “hoists, robot arms, or other work elements’ instead of the video cameras,” referring to column 9, lines 33-36. However, Benson does not address the problem of enabling additional manipulation activities as described above. Thus, Benson remains non-analogous art.

The Office Action has failed to state *prima facie* obviousness rejections of claims 1-8, the proposed combination does not result in the claimed inventions, there is no motivation to combine the references and Benson is non-analogous art. Therefore, the rejection of claims 1-8 under 35 U.S.C. § 103 has been overcome.

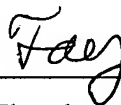
### **III. Conclusion**

It is respectfully urged that the rejections over Canaday are moot and that the subject application is patentable over Luffel and Benson. Thus, claims 1-20 should be in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: October 18, 2004

Respectfully submitted,

A handwritten signature in cursive script, appearing to read 'Fay', is written over a horizontal line.

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